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EXAMINER

ZECHER, MICHAEL R

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/707,327	Applicant(s) GERSTNER ET AL.	
	Examiner MICHAEL R. ZECHER	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a final Office Action on the merits. The Amendment/Remarks received on September 3, 2008, have been entered. **Claims 1, 6, 11, 21, & 26** have been amended. **Claims 1-35** are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 21-35** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 21, various "means for" are claimed, but there is no support for their corresponding structure in the specification, as required by § 112, 6th paragraph. The Examiner requests Applicant to either particularly point out the corresponding structures in the specification or remove the "means for" language.

Claims 22-25 dependent from claim 11 and are rejected under the same rationale set forth above.

As per claim 26, the preamble recites both a "computer-readable storage medium" and a "system." It is unclear which statutory class applicant wishes to claim. For examination purposes, the Examiner has construed the claim as a system claim without corresponding structure because engines may be interpreted as software. The Examiner recommends that Applicant remove "computer-readable storage medium" and change "engine" to "computer."

Claims 27-35 dependent from claim 26 and are rejected under the same rationale set forth above.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 21-35** are rejected under 35 U.S.C. 101 because the claimed invention is directed to not-statutory subject matter.

Claim 21 recites in the preamble “an apparatus to enable a financial institution to authorize third-party transactions for an account on behalf of an account holder, the apparatus comprising...”. The body of claim 21 recites various “means for” in each limitation. Claim 21 is considered non-statutory because the “means for,” without pointing out the corresponding structures in the specification, may be considered software, per se. Functional Descriptive material per se is not statutory. Functional Descriptive material in combination with an appropriate computer readable medium must be capable of producing a useful, concrete and tangible result when used in a computer system. Since the “means for” lacks structure or storage on a medium and there are no instructions in executable form, no underlying functionality occurs and thus there is no practical application. For these reasons, claim 21 fails to satisfy one of the statutory categories set forth in 35 U.S.C. 101 and is therefore considered to be non-statutory.

Claims 22-25 dependent from claim 21 and are rejected under the same rationale set forth above.

Claim 26 recites in the preamble “a system to enable a financial institution to authorize third-party transactions for an account on behalf of an account holder, the system comprising...”. The body of claim 26 recites various “engines” in each limitation. Claim 26 is considered non-statutory because the engines are considered to be software, per se. Functional Descriptive material per se is not statutory. Functional Descriptive material in combination with an appropriate computer readable medium must be capable of producing a useful, concrete and tangible result when used in a computer system. Since the “engines” lack storage on a medium and there are no instructions in executable form, no underlying functionality occurs and thus there is no practical application. For these reasons, claim 26 fails to satisfy one of the statutory categories set forth in 35 U.S.C. 101 and is therefore considered to be non-statutory.

Claims 27-35 dependent from claim 26 and are rejected under the same rationale set forth above.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. **Claims 1-35** are rejected under 35 U.S.C. 102(e) as being anticipated by Neofytides et al. (U.S. 7,376,587).

As per claim 1, Neofytides et al. teaches a method of processing account-holder requests to authorize recurring third-party transactions for an account at a financial institution on behalf of the account holder (See col. 1, lines 57, through col. 2, line 2, and col. 6, line 37, through col. 7, line 23, which discusses hardware and software for implementing an electronic money transfer, including recurring transactions), the method comprising:

receiving, at the financial institution, the account-holder request to authorize the third party transactions (See col. 5, line 38, through col. 6, line 9, which discusses how a payor initiates debiting his/her bank account in an electronic monetary transaction);

matching at least one specific request from among the account-holder requests to at least one specific third-party participant (See col. 11, line 62, through col. 12, line 8, which discusses matching requests to transfer money using a security question);

forwarding the at least one specific request to the at least one specific, third-party participant on behalf of the account holder (See col. 11, lines 48-56, which discusses sending a payee an email to confirm payment from a payor);

receiving, at the financial institution, at least one participant confirmation from the at least one specific third-party participant (See col. 11, lines 48, through col. 12, line 8, which discusses how a payee confirms approval of an electronic money transfer), wherein the at least one participant confirmation comprises a confirmation that the at least one specific third-party participant's accounting system has been updated based

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on the at least one specific request (See col. 13, lines 4-14, and col. 14, lines 20-27, which discusses updating transaction files); and

forwarding, from the financial institution, an account-holder confirmation of the at least one participant confirmation of the at least one specific request to the account holder (See col. 12, lines 34-46, which discusses how a payor confirms the transaction).

As per claim 2, Neofytides et al. teaches establishing a pre-existing list of prospective third-party participants, wherein the at least one specific third-party participant is selected from the pre-existing list (See col. 9, line 52, through col. 10, line 49, which discusses an address book that functions as a source of prospective payees).

As per claim 3, Neofytides et al. teaches wherein at least one of the forwarding of the at least one specific request to the at least one specific, third-party participant and the receiving, at the financial institution, the at least one participant confirmation from the at least one specific third-party participant is accomplished in accordance with participant communication preferences stored in a participant profile for the at least one specific third-party participant, the participant profile being stored in a data repository comprising participant profiles associated with the prospective third-party participants (See col. 10, line 49, through col. 11, line 19, which discusses registering an individual or payee's profile, storing the profile, and confirming the profile according to a preferred method).

As per claim 4, Neofytides et al. teaches wherein the forwarding, from the financial institution, of the account-holder confirmation of the at least one participant confirmation of the at least one specific request to the account holder is accomplished in

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accordance with account-holder communication preferences stored in an account-holder profile (See col. 8, lines 26-54, which discusses a user or payor profile and how a user or payor may confirm a money receipt method).

Claim 5 recites equivalent limitations to claim 4 and is therefore rejected using the same art and rationale set forth above.

As per claim 6, Neofytides et al. teaches wherein the account-holder requests comprise at least one direct-deposit request to authorize the at least one specific third-party participant to periodically direct deposit funds to the account (See col. 1, lines 57, through col. 2, line 2, and col. 4, lines 1-10, which discusses how a user directs recurring money transfer requests to another individual or entity).

Claims 7-10 recite equivalent limitations to claim 6 and are therefore rejected using the same art and rationale set forth above.

As per claim 11, Neofytides et al. teaches a computer program product comprising a computer-readable storage medium having a computer program embodied therein for enabling a financial institution to authorize recurring third-party transactions for an account on behalf of an account holder (See col. 1, lines 57, through col. 2, line 2, and col. 6, line 37, through col. 7, line 23, which discusses hardware and software for implementing an electronic money transfer, including recurring transactions), the computer program further comprising:

instructions for receiving account-holder requests, wherein specific requests from among the account-holder requests authorizes specific third party participants to perform a plurality of the recurring third-party transactions on behalf of the account

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holder (See col. 1, lines 57, through col. 2, and col. 5, line 38, through col. 6, line 9, which discusses recurring transactions; and, furthermore, how a payor initiates debiting his/her bank account in an electronic monetary transaction);

instructions for matching the specific requests from among the account-holder requests to the specific third-party participants (See col. 11, line 62, through col. 12, line 8, which discusses matching requests to transfer money using a security question);

instructions for forwarding the specific requests to the specific third-party participants on behalf of the account holder (See col. 11, lines 48-56, which discusses sending a payee an email to confirm payment from a payor);

instructions for receiving participant confirmations from the specific third-party participants (See col. 11, lines 48, through col. 12, line 8, which discusses how a payee confirms approval of an electronic money transfer); and

instructions for forwarding an account-holder confirmation of the participant confirmations of the specific requests to the account holder (See col. 12, lines 34-46, which discusses how a payor confirms the transaction).

Claims 12-14 recite equivalent limitations to claims 2-4, respectively, and are therefore rejected using the same art and rationale set forth above.

Claim 15 recites equivalent limitations to claim 4 and is therefore rejected using the same art and rationale set forth above.

Claim 16-20 recites equivalent limitations to claim 6 and are therefore rejected using the same art and rationale set forth above.

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As per claim 21, Neofytides et al. teaches an apparatus to enable a financial institution to authorize recurring third-party transactions for an account on behalf of an account holder (See col. 1, lines 57, through col. 2, line 2, and col. 6, line 37, through col. 7, line 23, which discusses hardware and software for implementing an electronic money transfer, including recurring transactions), the apparatus comprising:

means for receiving account-holder requests wherein specific requests from among the account-holder requests authorizes specific third party participants to perform a plurality of the recurring third-party transactions on behalf of the account holder (See col. 1, lines 57, through col. 2, and col. 5, line 38, through col. 6, line 9, which discusses recurring transactions; and, furthermore, how a payor initiates debiting his/her bank account in an electronic monetary transaction);

means for matching the specific requests from among the account-holder requests to the specific third-party participants (See col. 11, line 62, through col. 12, line 8, which discusses matching requests to transfer money using a security question);

means for forwarding the specific requests to the specific third-party participants on behalf of the account holder (See col. 11, lines 48-56, which discusses sending a payee an email to confirm payment from a payor);

means for receiving participant confirmations from the specific third-party participants (See col. 11, lines 48, through col. 12, line 8, which discusses how a payee confirms approval of an electronic money transfer); and

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means for forwarding an account-holder confirmation of the participant confirmations of the specific requests to the account holder (See col. 12, lines 34-46, which discusses how a payor confirms the transaction).

Claims 22-24 recite equivalent limitations to claims 2-4, respectively, and are therefore rejected using the same art and rationale set forth above.

Claim 25 recites equivalent limitations to claim 4 and is therefore rejected using the same art and rationale set forth above.

As per claim 26, Neofytides et al. teaches a computer-readable storage medium comprising a system to enable a financial institution to authorize recurring third-party transactions for an account on behalf of an account holder (See col. 1, lines 57, through col. 2, line 2, and col. 6, line 37, through col. 7, line 23, which discusses hardware and software for implementing an electronic money transfer, including recurring transactions), the system comprising:

a user interface to receive account-holder requests, wherein specific requests from among the account-holder requests authorizes specific third party participants to perform a plurality of the recurring third-party transactions on behalf of the account holder (See figure 1, col. 1, lines 57, through col. 2, and col. 5, line 38, through col. 6, line 9, which illustrates and discusses a user or payer computer, recurring transactions, and how a payor initiates debiting his/her bank account in an electronic monetary transaction);

at least one engine operatively connected to the user interface, the at least one engine to match the specific requests from among the account-holder requests to the

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specific third-party participant (See figure 1, and col. 5, line 38, through col. 6, line 9, which illustrates and discusses a payment enabler or intermediary, and how a payor initiates debiting his/her bank account in an electronic monetary transaction);

a third-party participant interface to forward the specific requests to the specific third-party participants, the third-party participant interface operatively connected to the at least one engine (See figure 1, and col. 11, line 62, through col. 12, line 8, which illustrates and discusses and payee or third party computer, and matching requests to transfer money using a security question)and ;

a least one data repository operatively connected to the at least one engine, the at least one data repository further comprising third-party participant profiles (See col. 10, line 49, through col. 11, line 19, which discusses registering an individual or payee's profile, storing the profile, and confirming the profile according to a preferred method); and

a fulfillment system to provide account-holder confirmation of the specific requests, the fulfillment system operatively connected to the at least one engine (See col. 12, lines 34-46, which discusses how a payor confirms the transaction).

Claim 27 recites equivalent limitations to claim 2 and is therefore rejected using the same art and rationale set forth above.

Claim 28 recites equivalent limitations to claim 6 and is therefore rejected using the same art and rationale set forth above.

Claim 29 recites equivalent limitations to claim 4 and is therefore rejected using the same art and rationale set forth above.

As per claim 30, Neofytides et al. teaches wherein the account-holder communication preferences comprises at least one of electronic and paper communication preferences (See claim 1, which discusses communicating by an email address).

Claim 31 recites equivalent limitations to claim 4 and is therefore rejected using the same art and rationale set forth above.

Claim 32 recites equivalent limitations to claim 30 and is therefore rejected using the same art and rationale set forth above.

As per claim 33, Neofytides et al. teaches wherein the user interface is operable to receive the account-holder requests from the account-holder over the internet (See figure 1, which illustrates receiving user requests over the internet).

Claims 34 & 35 recite equivalent limitations to claim 33 and are therefore rejected using the same art and rationale set forth above.

Response to Arguments

5. Applicant's arguments, see pg. 9 of the Remarks, filed September 3, 2008, with respect to the 35 U.S.C. § 101 rejection of **claims 11-20** have been fully considered and are persuasive. The 35 U.S.C. § 101 rejection of **claims 11-20** has been withdrawn.

6. Applicant's arguments with respect to **claims 11, 21, & 26** have been considered but are moot in view of the new grounds of rejection.

7. Applicant's arguments filed September 3, 2008, have been fully considered but they are not persuasive.

In the Remarks, Applicant argues in substance:

(a) There is support for the "means for" language of **claims 21-25** in the corresponding figures and specification.

(b) The 35 U.S.C. § 101 rejection has been overcome for **claims 21-25** and **claims 26-35**.

(c) Neofytides et al. does not disclose, teach, or suggest a financial institution or a financial institution that receives authorization.

In response to (a):

The Examiner respectfully disagrees with Applicant's assertion. **Claims 21-25** contain means plus function limitations in which the disclosed structure is a computer or a microprocessor programmed to carry out an algorithm. However, the corresponding structure must include a specific algorithm disclosed in the specification. Because the specification lacks any specific algorithm or any step-by-step process for performing the claimed functions of "means for receiving", "means for matching", "means for forwarding the specific request", or "means for forwarding an account-holder confirmation", the computer asserted in the drawings and specification is insufficient to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In response to (b):

The Examiner respectfully disagrees with Applicant's assertion. First, in regards to **claims 21-25**, figures 2, 4, and 5 and the corresponding descriptions simply refer to a computer without specifically outlining the exact algorithm used to carry out each "means for" step. The claim language may be broadly and reasonably interpreted as software. The Examiner maintains that since the "means for" lacks a computer or a

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microprocessor programmed to carry out an algorithm and there are no instructions in executable form, no underlying functionality occurs and thus there is no practical application.

Second, in regards to **claims 26-35**, the preamble of claim 26 recites both a “computer-readable storage medium” and a “system.” It is unclear which statutory class applicant wishes to claim. If Applicant wishes to claim a system, there must be corresponding structure in the claim language (i.e. computer and memory). If Applicant wishes to claim a computer-readable medium, there must be instructions in executable form. The Examiner recommends that Applicant remove “computer-readable storage medium” and change “engine” to “computer.”

In response to (c):

The Examiner respectfully disagrees with Applicant’s assertion. It is inherent from the disclosure in Neofytides et al. that a financial institution is utilized to receive authorization requests. The Examiner refers Applicant to the bank accounts used to complete the payment transaction (See col. 2 lines 40-47, and col. 5, lines 38-45). A bank account does not exist without a corresponding bank. Furthermore, banks are not authorized to transfer funds without the express consent of the corresponding bank account holder. These two concepts go hand-in-hand and are inherently disclosed in Neofytides et al.

Conclusion

8. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. ZECHER whose telephone number is (571)270-3032. The examiner can normally be reached on M-F 7:30-5:00 alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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